

REMARKS

Claims 1 to 23 have been rejected. With this Reply to Office Action, claims 1, 7 and 20 have been amended to distinguish with more particularity a non-dispersant polymethacrylate from its dispersant counterpart. The amended claims are supported in the original specification, for example, at page 8, line 16, to page 11, line 4. Accordingly, no new matter has been added.

A certified copy of the priority European application has been submitted herein as an attachment. This submission should obviate the Examiner's concern regarding priority.

Solely to expedite allowance without acquiescing to the provisional double-patenting rejections, Applicants also submit a terminal disclaimer in compliance with 37 C.F.R. 1.321(c).

In view of the amendments and remarks herein, Applicants respectfully request the withdrawal of all rejections.

1. Priority:

Applicants thank the Examiner for acknowledging the claim of foreign priority based on an application filed in Europe on November 28, 2003. In full compliance with 35 U.S.C. § 119(b), Applicants hereby submit a certified copy of the EP 03292968.9 application, which was originally filed in English.

2. Claim Rejections – 35 U.S.C. § 102

The Examiner rejected claims 1-2, 5, and 20-21 under 35 U.S.C. § 102(b) as allegedly being anticipated by Li, in view of Solozhenko. Specifically, the Examiner stated that Li “disclosed a lubricant composition comprising a non-aqueous lubricant … a polymethacrylate … a concentration of 0.5 to 20% by weight of boron nitride … a concentration of 0.5 to 15% by weight of polymethacrylate.” Action at page 2, line 16, to page 3, line 1. The Examiner also alleged that the ratio of boron nitride to polymethacrylate disclosed by Li falls “well within the ranges recited in Claims 1 and 20.” *Id.* at page 3, lines 2-3. Moreover, the Examiner stated that the lubricant composition of Li may comprise a surfactant. *Id.* at page 3, lines 4-5.

The Examiner acknowledged that “Li disclosed the genus of boron nitride without any indication of the desired morphological species.” *Id.* at lines 6-7. To find such a desired morphological species, the Examiner resorted to Solozhenko as allegedly providing “evidence that there are four species of boron nitride – hexagonal, rhombohedral, cubic, and wurtzitic.” *Id.* at lines 7-8. Citing *In re Schaumann*, 572 F.2d 312 (C.C.P.A. 1978), the Examiner reasoned that because of “the limited number of species encompassed by boron nitride, the use of the hexagonal species is anticipated.” Action at page 3, lines 8-10.

Applicants respectfully traverse, especially with the Examiner’s use of Solozhenko in a 35 U.S.C. § 102 (b) rejection. Applicants respectfully submit that the Examiner’s interpretation of the holdings of *In re Schaumann* is incomplete if not misguided. Specifically, *In re Schaumann* does not undermine the well-settled law that, to anticipate, a single prior art reference must place the inventive compound or

composition in the possession of the public. *See In re Brown*, 329 F.2d 1006, 1011 (C.C.P.A. 1964). *Accord, Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047 (Fed. Cir. 1995) (holding that the prior art reference must disclose each and every feature of the claimed invention). The *Shcaumann* case stands not only for the proposition that “a genus may anticipate a claimed species of the number of possible species within the specific genus is sufficiently limited,” (*id.* at 10-12) (*emphasis added*), but also for the proposition that the prior art reference cited as anticipating must sufficiently disclose “a pattern of preferences” that would point the skilled person in the art to narrow the disclosed genus in the right direction. *See, e.g., Sanofi-Synthelabo v. Apotex, Inc.*, 470 F.3d 1368, 1377 (Fed. Cir. 2006) (stating that “our predecessor court found a ‘pattern of preference’ in *Petering* and *Schaumann*,” and distinguishing the facts of the case at hand from *Peter* and *Schaumann* by the lack of “such clear ‘pattern of preference’ that serves to narrow the genus in claim 2 to a narrow class that includes [the desired compound].”); *see also Schering Corp. v. Precision-Cosmet Co.*, 614 F. Sup. 1368, 1373 (D. Del. 1985) (reading *In re Schaumann* to hold that anticipation may be found if “it is possible to derive a class of compounds of lesser scope than the genus disclosed in a prior art reference on the basis of preferences ascertainable from the remainder of the reference … to enable one to practice the invention without experimentation.”) (*emphases added*). It should be noted that instead of a “without-undue-experimentation” standard, a “without-experimentation” standard must be met before a prior art reference can be found to anticipate. In other words, if any experimentation is needed to identify the claimed species from even a limited number of species in the genus, then the reference disclosing that genus would not be anticipating unless that reference itself teaches which species to

select and how to make the selection. Thus, if and only if the purported reference discloses both a genus of limited species and a “pattern of preference” that may be used by a skilled person in the art to select from the genus without any experimentation will that reference be anticipating.

Here, as the Examiner has acknowledged, “Li disclosed the genus of boron nitride without any indication of the desired morphological species.” Action at page 3, lines 6-7. Accordingly, the Li reference does not disclose a required “pattern of preference.” Regardless of whether Li discloses a genus of limited species, then, Li cannot anticipate claims 1-2, 5, and 20-21 under 35 U.S.C. § 102. Applicants respectfully request the withdrawal of this rejection.

Claims 1-2, 6, 9, 20-21 and 23 have also been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Pachoke in view of Solozhenko. Action at page 3, lines 13-15. Specifically, the Examiner alleged that “Pacholke discloses … an additive composition comprising boron nitride … an ethylene propylene olefin copolymer, … and a carrier fluid.” *Id.* at lines 16-19. The Examiner further alleged that Pacholke discloses ethylene-propylene copolymers as dispersants. *Id.* at lines 19-20. According to the Examiner, Pacholke also discloses that “the additive is added to a lubricating oil, specifically a gear oil,” (*id.* at page 4, lines 1-2), and an olefin-copolymer may be present in 25% by weight in the additive composition (*id.* at lines 4-5).

Again, the Examiner acknowledged that “Pacholke disclosed the genus of boron nitride without any indication of the desired morphological species.” *Id.* at lines 9-10. For the reasons stated above in the discussions regarding Li, Applicants respectfully

submit that Pacholke is not a proper 35 U.S.C. § 102 reference for it does not disclose both a genus of limited species and the “pattern of preferences” that would lead a skilled person in the art to the instantly obtain the claimed invention without any experimentation. Accordingly, claims 1-2, 6, 9, 20-21 and 23 are not anticipated by Pacholke.

Moreover, novelty can be asserted with equal force from the fact that Pacholke did not disclose a dispersant viscosity index improver in the lubricant composition. As the Examiner has acknowledged in the Office Action, Pacholke disclosed “an additive composition comprising 25% of the olefin copolymer by weight [I]t is clear that the carrier fluid and the solid lubricant (boron nitride) must make up the other 75%,” because “the disclosure does not reveal the possibility of any additional components in the additives.” Action at page 4, lines 4-7. While Pacholke does disclose an olefin copolymer, that copolymer is not a dispersant viscosity index improver but rather a stabilizing agent. *See, e.g.*, Pacholke, at column 5, lines 21-25 (“The stabilizing agents used in the compositions and the methods of the present invention are selected from the group consisting of ethylene propylene copolymers having substantially equivalent proportions of ethylene and propylene monomers.”). There is no mention in the Pacholke that such a copolymer has dispersancy or dispersant functionality.

It is known in the art that olefin copolymers are not dispersant by nature. For instance, the text book, LUBRICANT ADDITIVES CHEMISTRY AND APPLICATIONS, defines a dispersant as a molecule that “consists of three distinct structural features: a hydrocarbon group, a polar group, and a connecting group or a link.” Section 5.5, Dispersant Structure, LUBRICANT ADDITIVES CHEMISTRY AND APPLICATIONS, *Rudnick* ed. Marcel

Dekker, Inc. (2003) (enclosed as Attachment 2). Accordingly, a polymethacrylate is distinct from a dispersant polymethacrylate, and an olefin copolymer is distinct from a dispersant olefin copolymer.

Specifically, dispersant olefin copolymers, such as the herein claimed ethylene-propylene copolymers, contain polar groups that have been incorporated into their backbones, or have become grafted to the backbones as side-chains. Only polar ethylene-propylene copolymers can be used as dispersants. Dispersancy can be introduced *via* reactions of polar co-monomers with ethylene-propylene copolymers. *See, e.g.*, description, at page 14, lines 8- 24 (describing polar groups, including preferred polar groups, that might be used to add dispersancy to copolymers); page 15, lines 22-26.

Having not disclosed an ethylene propylene copolymer that is dispersant, and having not disclosed any polymethacrylates, dispersant or non-dispersant, Pacholke could not have anticipated instant claims 1-2, 6, 9, 20-21 and 23. Accordingly, Applicants respectfully request the withdrawal of this rejection.

3. Claim Rejections - 35 U.S.C. § 103.

Claim 1 was rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Li in view of Dickey. Action at page 5, lines 12-14. Specifically, the Examiner stated that while “Li does not specifically disclose hexagonal boron nitride,” that gap in disclosure was filled by Dickey because the latter allegedly disclosed that “hexagonal boron nitride provides ‘excellent lubrication’” without mentioning any other types of boron nitride. *Id.* at lines 14-17. Applicants respectfully traverse on the following grounds.

First, a person of ordinary skill in a particular art of interest will not likely know about prior art in a different and unrelated field of technology. Such art, therefore, would not have rendered an invention obvious. MPEP § 2141.01(a); *see also In re Clay*, 996 F.2d 656, 658-59 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). The only circumstance under which a reference not entirely related to the inventor's field of endeavor may constitute analogous art is when, "because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d at 659. The test of whether such a logical connection exists when the reference is not within the field is whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. *Id.* at 658-59 (holding that the reference in question was not in a related field of technology because the reference dealt with avoiding dead volumes when extracting crude petroleum whereas the invention at issue concerned avoidance of dead volumes when storing refined liquid hydrocarbons). *Compare, Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535 (Fed. Cir. 1983) (holding that rubber hose art was analogous to claimed tubing used to convey pressurized fuel lubricants and other fluids); *In re Mlot-Fijalkowski*, 676 F.2d 666, 670 (C.C.P.A. 1982) (holding that dye art in generally is sufficiently analogous to the invention relating to dye penetrant indications).

Here, the Li reference concerns a process of lubricating a container, such as a food or beverage container, in which materials are or will be handled or carried. The claimed invention here concerns the use of certain additives in a transmission oils used to lubricate automobile transmissions and differentials, pneumatic tools, gas compressors, centrifuges, high-pressure hydraulic systems, metal working and similar devices, and

various types of bearings. The difference between the art of lubricating a food container and the art of blending and applying a transmission oil is at least as significant as the difference between the dead volume avoidance in petroleum extraction and dead volume avoidance in refined hydrocarbon storage. It is certainly much more substantial than the difference between an art of rubber hose and an art of tubing, or the difference between the dye art generally and the specific area of dye penetration. Applicants respectfully submit that the Examiner has not provided evidence that a skilled person in the art of blending and applying transmission gear oils will likely be motivated by a reference in the food container art. Thus, a *prima facie* case of obviousness has not been made and this rejection is improper on this ground alone.

Second, before a reference can constitute legally cognizable prior art, it must teach or suggest how to make what it discloses. Along those lines, then, when no known method for practicing the invention at issue exists, the mere naming of the embodiment in a reference, without a teaching of how to make and use it, will not constitute an enabling description of the embodiment. *See In re Hoeksema*, 399 F.2d 269, 274 (C.C.P.A. 1968). Here, Li expressly provides that “[t]he lubricant should generally be non-toxic and biologically acceptable.” Li at column 5, lines 50-51. Boron nitride, while named without specificity as an example of known solid lubricants, was known to be unsuitable for use in contact with foods or items otherwise ingested by humans. *See, e.g.*, Boron & Compound Fact Sheets by the Australian government, *available at* <http://www.npi.gov.au/database/substance-info/profiles/15.html> (stating that boron compounds are dissolvable in digestive juices once ingested, causing injurious or toxic consequences to humans); GE Advanced Materials Is First & Only Manufacturer to Offer

Boron Nitride Powders With NSF Registration for Incidental Food Contact, Press Release, May 16, 2005, at www.advceramics.com/geac/downloads/documents/FINAL%20%20GE%20Boron%20Nitride%20NSF%20Registration%20PR.pdf (stating that most if not all grades of boron nitrides available at the time of the press release are not suitable for use in contact with food items, and that even the GE's new BN powders are only permissible in incidental contact with foods). Therefore, when the present application was filed in 2003, there was no way of using hexagonal boron nitride in accordance with the description of Li because the use of such material would necessarily compromise the safety and biological acceptability requirement contained therein. Rather than seeking to improve lubricity by improving boron nitride, a person skilled in the art reading Li at the time of this application would be much more inclined to improve other non-boron nitride lubricants.

Moreover, the authors of Li appeared quite satisfied with the results of their invention, and there is nothing in Li to indicate a motivation or need to improve on the lubricity of the composition at all. Specifically, the Applicants of Li stated that “[t]he present invention is advantageous as compared to prior art aqueous lubricants because the substantially nonaqueous lubricants have good compatibility with PET, superior lubricity, low cost because large amounts of water are not used” Li at column 5, lines 53-57 (*emphasis added*). The motivation to modify boron nitride could not have come from Li because, if anything, Li pointed the skilled person away from using boron nitride for the intended purpose of lubricating food containers and conveyers. Without such motivation, there would be no reason for a person skilled in the art to turn to a treatise like Dickey. Applicants thus respectfully submit that the Examiner has used

impermissible hindsight in combining these references, finding the motivation to modify Li from the instant application. Accordingly, this rejection is improper and should be withdrawn.

The Examiner further rejected claim 1 as being allegedly obvious over Pacholke in view of Dickey. Action at page 5, lines 22-24. Specifically, the Examiner incorporated the § 102 rejection based on the same reference, but acknowledged that “Pacholke does not specifically disclose hexagonal boron nitride.” *Id.* at page 6, line 2. According to the Examiner, Dickey disclosed that “hexagonal boron nitride provides ‘excellent lubrication,’” and did not mention other types of boron nitride. *Id.* at lines 3-4.

Applicants respectfully traverse. As discussed above, aside from not disclosing hexagonal boron nitride, Pacholke also failed to disclose a dispersant ethylene propylene copolymer or a dispersant or non-dispersant polymethacrylate viscosity index improver. Without acquiescing to the Examiner’s contention regarding Dickey, Applicants submit that the references cited by the Examiner here do not disclose each and every element of instant claim 1. Because the PTO bears the burden of establishing a *prima facie* case of obviousness, and one aspect of that burden lies in providing evidence that the prior art reference or combination of references teach or suggest all the limitations of the claim at issue (see MPEP § 2142), claim 1 cannot have been rendered obvious by Pacholke in view of Dickey.

The Examiner further rejected claim 3 for allegedly being obvious over Li in view of De Vries. Action at page 6, lines 8-9. Specifically, the Examiner incorporated the §

102 rejection on the basis of Li but acknowledged that “Li does not disclose a particle size distribution for boron nitride.” *Id.* at lines 10-11. According to the Examiner, De Vries disclosed boron nitride, which “preferably ha[ving] a maximum particle size of as low as 0.001 microns.” *Id.* at lines 12-15.

Applicants respectfully traverse. As discussed above and as the Examiner has repeatedly acknowledged, the Li reference does not disclose a hexagonal boron nitride. Nor does De Vries. Moreover, neither Li nor De Vries contains any suggestion that hexagonal boron nitride be used in the lubricant composition. Failing to disclose or suggest each and every limitation, these two references cannot be and should not have been combined to render claim 3 obvious.

Claim 3 was further rejected as allegedly being obvious over Pacholke in view of De Vries. Action at page 6, lines 19-20. Specifically, the Examiner incorporated the § 102 rejection on the basis of Pacholke but acknowledged that “Pacholke does not disclose a particular size distribution for boron nitride.” *Id.* at page 7, lines 1-2. The Examiner repeated the contention that De Vries disclosed boron nitride having a particular size of as low as 1 millimicrons. *Id.* at lines 3-5.

Applicants respectfully traverse without acquiescing to the Examiner’s contention that the combination of these references renders the small-particle boron nitride obvious. As discussed above, Pacholke did not disclose a hexagonal boron nitride, nor did it indicate a preference for a boron nitride of such a conformation. The De Vries reference does not fill the void left by the Pacholke reference, because De Vries does not disclose

or suggest a boron nitride of hexagonal conformation. Having failed to disclose or suggest each and every element, these two references do not render claim 3 obvious.

Claim 4 and 22 have been rejected for allegedly being obvious over Pacholke. Action at page 7, lines 10-11. Specifically, the Examiner incorporated the § 102 rejection on the basis of Pacholke but acknowledged that “Pacholke does not specifically disclose a concentration of between 1 and 50% by weight of boron nitride in oil, or a concentration of between 1 and 20% of the additive composition in the lubricant composition.” *Id.* at lines 12-15. Moreover, the Examiner stated that “Pacholke disclosed a concentration of between 0.01 and 65% for boron nitride within the full additive composition … [and] a concentration of between 3.0 and 5.0% by weight for the olefin copolymer component.” *Id.* at lines 16-19. The Examiner then stated that the dispersion of boron nitride “makes up between 95 and 97% by weight of the additive composition, meaning that the concentration of boron nitride in the oil is between 0.01 and about 68%.” *Id.* at page 7 line 19, to page 8, line 2. The Examiner further stated that Pacholke disclosed the boron nitride concentration as a result-effective variable, and such a variable would not support the patentability unless there is evidence indicating the concentration is critical. *Id.* at lines 2-10. Along these lines, the Examiner also stated that Pacholke disclosed in Examples 1-3 additive compositions comprising equal amounts of a solid lubricant and a neutral petroleum oil, from which a 50% dispersion as recited in claim 4 may be strongly suggested. *See id.* at lines 10-17. The Examiner concluded that Pacholke disclosed a range of the additive composition in the finished oil that substantially overlaps the range recited in the instant claim 22. *See id.* at lines 18-20.

Applicants respectfully traverse this rejection without acquiescing to the Examiner's contentions regarding what is suggested by Pacholke. As discussed above, Pacholke does not disclose or suggest each and every element of claims 4 and 22 because it failed to disclose a dispersant olefin copolymer, or a dispersant or non-dispersant polymethacrylate, which constitutes an element of claims 4 and 22 as the result of their dependencies from claims 1 and 22, respectively. There is no suggestion in Pacholke that such a material be used and the Examiner has provided no evidence of such a suggestion. Thus, claims 4 and 22 are not rendered obvious by Pacholke.

Claims 1, 7, 8 and 20 have been rejected as allegedly being obvious over Li in view of Ishikawa. Action at page 9, lines 1-2. Specifically, the Examiner incorporated the § 102 rejection on the basis of Li, but acknowledged that "Li does not specifically disclose a dispersant polymethacrylate ... [or] a hydrocarbon side chain on a polymethacrylate." *Id.* at lines 3-8. The Examiner stated that Ishikawa, however, disclosed "both non-dispersant and dispersant polymethacrylates as an additive for enhancing the viscosity index of a lubricant composition, ... [and] that the dispersant polymethacrylate has a hydrocarbon chain with 1 to 18 carbons." *Id.* at lines 9-17.

Applicants must again traverse. As discussed above, a dispersant polymethacrylate is not the only thing Li failed to disclose. Specifically, Li did not disclose a hexagonal boron nitride in the lubricant composition. Moreover, the disclosure of boron nitride is not enabled. No suggestion to combine the Li reference and the Ishikawa reference can be found in either Li or Ishikawa. Applicants respectfully submit

that the Examiner has not carried the burden of making out a *prima facie* case of obviousness here and this rejection is as a result improper.

Claims 10-13 and 15-19 have been rejected for allegedly being obvious over Li in view of Peeler. Action at page 10, lines 1-2. Specifically, the Examiner incorporated the § 102 rejection on the basis of Li, but admitted that “Li does not disclose a hydrated alkali metal borate.” *Id.* at lines 3-4. The Examiner then described Peeler as disclosing “an oil dispersion of an alkali metal borate and a dispersant … [and] that the alkali metal may be sodium or potassium.” *Id.* at lines 5-8. Moreover, the Examiner stated that Peeler disclosed a borate concentration of 2 to 60% by weight, which allegedly overlaps with the broad ranges recited in the instant claims 15 and 19, and encompasses the range recited in claim 16. *Id.* at lines 8-12. Furthermore, the Examiner stated that Peeler disclosed a detergent “in a concentration of 0.1 to 5%, overlapping the range recited in Claim 18.” *Id.* at lines 13-16.

Applicants respectfully traverse, especially with the Examiner’s contention that “[i]t would have been obvious to one of ordinary skill in the art to include in the lubricant composition of Li the oil dispersions of hydrated alkali metal borated disclosed by Peeler in order to obtain better extreme pressure lubricating performance.” *See* Action at page 10, lines 17-19. Contrary to the Examiner’s contentions, there is no suggestion in the Li reference that there exists a need to improve extreme pressure lubricating performance. Indeed, Li concerns the lubrication of food and beverage containers as well as conveyers. It is difficult to envision the need for extreme pressure lubrication at all because food and beverage containers and their conveyers are typically not subject to such pressure. The

Li reference does indeed describe certain additives that are typically used in the dual capacity of antiwear and extreme-pressure additive. *See* Li at column 4, lines 43-51. But it gave no indication that there is a need to improve upon the antiwear capacity of the lubricant composition it recites. *See id.* It should also be noted that no antiwear additive was used in the Examples. *See id.*

Thus, a person skilled in the art will not be motivated by the Li reference to look for improved extreme pressure properties. Applicants submit that the Examiner has impermissibly looked for the motivation to combine Li and Peeler from the instant application, because such a motivation assuredly does not exist in either Li or Peeler.

Moreover, as stated above, the Li reference failed to disclose a hexagonal boron nitride, and did not suggest or indicate a preference of such a material. There is nothing in Peeler that will serve to fill this gap. Thus, even if these references are combined, which would certainly be improper here, they still would not teach or suggest each and every element of claims 10-13 and 15-19.

Claims 10-13 and 15-19 have also been rejected for allegedly being obvious over Pacholke in view of Peeler. Action at page 11, lines 1-2. Specifically, the Examiner incorporated the § 102 rejection on the basis of Pacholke, but acknowledged that “Pacholke does not disclose a hydrated alkali metal borate.” *Id.* at lines 3-4. The Examiner stated that Peeler discloses “an oil dispersion of an alkali metal borate and a dispersant ..., that the alkali metal may be sodium or potassium ..., [and] that the borate is present in the oil dispersion in a concentration of 2 to 60% by weight.” *Id.* at lines 5-12. Moreover, the Examiner alleged that Peeler disclosed a detergent at a concentration

of 0.1 to 5%, which allegedly overlaps with the range recited in claim 18. *Id.* at lines 13-16.

Applicants respectfully traverse. First, as discussed above, Pacholke failed to disclose any dispersant olefin copolymers, or any dispersant or non-dispersant polymethacrylates as viscosity index improvers. Nor did Peeler teach or suggest the use of these materials. Second, there was no suggestion in Pacholke to motivate one skilled in the art to seek improved extreme pressure properties. Accordingly such a person will not be motivated to combine the disclosures of Pacholke and Peeler. Therefore, claims 10-13 and 15-19 are not rendered obvious by Pacholke in view of Peeler.

Claim 14 has been rejected as allegedly being obvious over Li in view of Peeler and further in view of Brown. Action at page 12, lines 3-5. Specifically, the Examiner incorporated the earlier § 103 rejection based on Li in view of Peeler, but acknowledged that “Li in view of Peeler does not disclose hydrated potassium triborate as an alkali metal additive.” *Id.* at lines -8. Moreover, the Examiner described Brown as disclosing “the use of hydrated potassium triborate as a preferred alkali metal borate.” *Id.* at lines 9-10.

Applicants respectfully disagree. First and foremost, Brown relates not to a lubricating oil composition but to a grease formulation. Specifically, the alkali metal borate additive was “added to the grease in an amount sufficient to impart extreme-pressure properties to the grease.” Brown, at column 2, lines 30-32. For this reason, a person skilled in the art of formulating and applying lubricating oil compositions is unlikely to be motivated to consult a reference relating to a grease additive unless there is

specific suggestion in the other references that grease additives may be suitable. There is no such suggestion in either Li or Peeler. Applicants thus respectfully submit that the Examiner has used improper hindsight when combining Li, Peeler and Brown, finding the motivation to do so in the instant application. Thus, this rejection is improper and should be withdrawn.

Claim 14 has also been rejected for allegedly being obvious over Pacholke in view of Peeler, and further in view of Brown. Action at page 12, lines 14-16. Specifically, the Examiner incorporated the earlier § 103 rejection based on Pacholke in view of Peeler, but admitted that “Pacholke in view of Peeler does not disclose hydrated potassium triborate as an alkali metal borate additive.” *Id.* at lines 17-19. The Examiner further suggested that Brown disclosed the use of hydrated potassium triborate as a preferred alkali metal borate.

Applicants respectfully traverse. For the reasons discussed above, a skilled person will not combine the references of Pacholke, Peeler and Brown. Nor will that person be motivated to modify Pacholke in light of the disclosures of grease additives in Brown. In addition, Pacholke failed to disclose dispersant olefin copolymers, or dispersant or non-dispersant polymethacrylates as viscosity index modifiers. Neither Peeler nor Brown can be used to fill that gap. Accordingly, Applicants submit that the Examiner has again used impermissible hindsight in combining these references, finding the motivation to do so only from the instant application. This rejection is therefore improper and should be withdrawn.

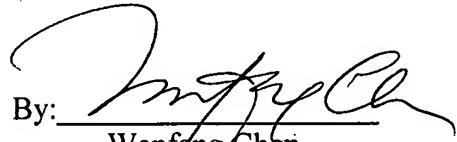
4. Double Patenting

The Examiner rejected claims 1-23 provisionally as allegedly being unpatentable over claims 1-17 of copending Application No. 10/624,240¹ in view of Papay. Solely to expedite allowance, and without acquiescing to the rejection, Applicants submit a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) herewith. Applicants believe this submission should obviate the Examiner's concerns and respectfully request the withdrawal of this rejection.

Applicants respectfully request the entry of this paper and favorable reconsideration of the pending claims. Please charge any additional required fees to deposit account No. 03-1620.

Respectfully submitted,

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WCCI/kcum
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¹ Application 10/624,240 was copending at the time of this Action. It was unintentionally abandoned on February 20, 2007, but was immediately revived by the filing of a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b) on the same day (Confirmation No. 7571). Thus, as of the date of this Reply, Application 10/624,240 stands copending with the present application.